

REMARKS

Status of the Claims

Claims 273 to 300 are pending.

Restriction

Restriction between one of two allegedly distinct groups has been required:

Group I (claims 273 to 298), drawn to a population of host cells comprising a polynucleotide encoding a fusion protein, a transcriptional regulatory sequence comprising a binding site for a DNA-binding domain, and a reporter gene; and

Group II (claims 299 and 300) drawn to methods for detecting an interaction between a polypeptide sequence and a DNA sequence.

Traversal

Applicant traverses the Restriction Requirement, for the following reasons. In support of restriction between Groups I and II (host cells comprising fusion polypeptides and methods of using these host cells), the Examiner stated, in part (Restriction Requirement, pages 2-3):

Inventions I and II are related as product and process of use. ... In the instant case the population of host cells of the Invention of Group I may be used to synthesize a fusion protein, which is a materially different process from detecting an interaction between a polypeptide sequence and a DNA sequence, as in the Invention of Group II.

Applicants submit that this is not a proper basis for Restriction because the asserted materially different process of fusion protein production has not been supported by specific, substantial and credible utilities. In certain embodiments, the cells of Group I contain libraries of at least 10^7 different fusion proteins (*see, e.g.*, last two lines of claim 273). However, the Office has not provided any evidence showing that a fusion protein could be produced from such cells. Accordingly, if Restriction between Groups I and II is maintained, the Examiner is asked to provide such evidence and, moreover, to identify specific, substantial and credible uses for fusion proteins produced by the cells of Group I. In the absence of such information, the Restriction cannot be maintained.

Furthermore, the methods of Group II depend from claim 273 of Group I and, as such, include all the limitations of the cells of Group I. Thus, a search of art relevant to the cells of Group I would necessarily and inevitably reveal references relevant to methods of using these cells. Since one such search would reveal all relevant references, searching the claims of Groups I and II together would not be unduly burdensome and would in fact save time and resources.

In any event, the method claims of Groups II contain all the limitations of elected Group I. Therefore, rejoinder of Group II is in order.

Solely for the purposes of compliance with 37 C.F.R. § 1.142, Applicants elect Group I, **with traverse**.

Election of Species

The Examiner, in the Election Requirement, required election of one species in each of the following groups:

- I) host cells;
- II) a particular activation tag and a particular and specific polypeptide sequence to be assayed for interaction with the DNA sequence;
- III) a particular and specific transcriptional regulatory sequence and a particular and specific DBD recognition element; and
- IV) a particular and specific reporter gene.

Applicants **traverse** the election of species requirement on the grounds that a search for each allegedly distinct species is in no way unduly burdensome. Indeed, a search of the art for any host cell (prokaryotic or eukaryotic) comprising a fusion protein including any activation tag and any reporter gene would necessarily and inevitably reveal art relevant to all allegedly distinct species. There is no search burden involved in searching all species together and accordingly, the election of species requirement should be withdrawn.

Solely to be fully responsive, Applicants elect, with traverse:
a prokaryotic cell, which reads on pending claims 273 to 300;

a Gal11P activation tag and a zinc finger polypeptide sequence to be assayed for interaction with a DNA sequence, which reads on pending claims 273 to 275, 277, and 280 to 300;

a His3 reporter gene, which reads on claims 273 to 286 and 293 to 300.

Applicants note that it is not possible to select a particular and specific transcriptional regulatory sequence and a particular and specific DBD recognition element. Indeed, the point of the claims is to test multiple sequences at these elements. *See, e.g.*, claims 293 and 294 regarding libraries including multiple, random sequences for the DBD.

It is to be understood that the foregoing election of species is for the purposes of preliminary search and examination only, and that upon allowance of a generic claim, applicants will be entitled to consideration of claims to the additional species. *See*, M.P.E.P. § 809.


Conclusion

Applicants expressly reserve their right under 35 USC § 121 to file one or more divisional applications directed to the nonelected subject matter during the pendency of this application.

Furthermore, should the Examiner choose to make this restriction requirement FINAL, Applicants reserve their right, pursuant to 37 C.F.R. §§ 1.144 and 1.181, to petition this requirement at any time during the pendency of this application, prior to appeal.

Respectfully submitted,

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